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09/490,553	01/25/2000	Jeffrey A. Morgan	10992213-1	7289

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EXAMINER

LIN, KENNY S

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/490,553

Applicant(s)

MORGAN ET AL.

Examiner

Kenny Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. Claims 1-35 are presented for examination.

**Response to Amendment**

2. The Declaration filed on 10/22/2003 under 37 CFR 1.131 is sufficient to overcome the Daswani reference.

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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5. Claims 1-2, 4, 10-11, 13, 15-16, 19-20, 22-24, 29 and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Cardillo, IV et al (hereinafter Cardillo), U.S. Patent 5,937,041.

6. As per claim 1, Cardillo taught the invention substantially as claimed including a system for providing Internet-related services in response to a handheld device without requiring the handheld device to itself be Internet-enabled, (col.1, lines 28-32, col.5, lines 47-67), comprising:

- a. A client module embedded in the handheld device to enable the handheld device to send a selected stored URL via a local communication link, wherein the URL indicates a desired Internet web page (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 1-3, 10-27, 45-47, col.7, lines 1-12, it is inherently known that the request can be a URL for retrieving a web page);
- b. A receiver that receives the URL sent from the handheld device via the local communication link (col.6, lines 1-10, 17-19, col.7, lines 1-12);
- c. A web access module coupled to the receiver and to an external Internet via an Internet communication link different from said local communication link to access and retrieve the desired web page from a remote web server via the external Internet (col.6, lines 4-10, it is inherently known that server with Internet connectivity requires a web access module such as modem or Ethernet); and
- d. A render system coupled to the web access module to render the retrieved web page to the user of the handheld device (col.4, lines 37-41, col.7, lines 13-18, 28-43).

7. As per claim 13, Cardillo taught the invention as claimed including a system for providing an Internet-related service from a remote Internet-related server via an Internet communication link based on a URL indicated by a handheld device (col.1, lines 28-32, col.5, lines 47-67), comprising:

- a. A receiver module to receive the URL from the handheld device via the communication link (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 1-27, 45-47, col.7, lines 1-12, it is inherently known that the request can be a URL for retrieving a web page);
  - b. A web access module to access and retrieve the Internet-related service via the Internet communication link based on the URL (col.6, lines 4-10, it is inherently known that server with Internet connectivity requires a web access module such as modem or Ethernet);
  - c. A render system module to render the retrieved Internet-related service (col.4, lines 37-41, col.7, lines 13-18, 28-43),
- wherein the receiver module, the web access module, and the render module are all physically separated from the handheld device (fig. 2).

8. As per claim 29, Cardillo taught the invention as claimed including a mobile system capable of communicating with a gateway module, which comprise a web access module to access and retrieve an Internet-related service from a remote Internet-related server via an Internet communication link based on a URL (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 4-10, it is inherently known that server with Internet connectivity requires a web access module

such as modem or Ethernet); and a render module to render the received Internet-related service (col.4, lines 37-41, col.7, lines 13-18, 28-43), the mobile system comprising:

- a. A client module to enable sending the URL via a communication link to the gateway module for use in the access and retrieval of the Internet-related service, wherein the gateway module communicates the retrieved Internet-related service with the rendering module, which renders of the retrieved Internet-related service in proximity to the mobile system (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 1-3, 10-27, 45-47, col.7, lines 1-12, it is inherently known that the request can be a URL for retrieving a web page).

9. As per claim 32, Cardillo taught the invention as claimed including a gateway system capable of receiving a communication including URL via a communication link from a mobile system (col.2, lines 41-46, col.5, lines 61-64, col.6, lines 1-3, 10-27, 45-47, col.7, lines 1-12, it is inherently known that the request can be a URL for retrieving a web page), said gateway system comprising:

- a. A communication module to receive the communication from mobile system (col.6, lines 1-27, 45-47, col.7, lines 1-12);
- b. A web access module to access and retrieve an Internet-related service from a remote Internet-related server via an Internet communication link based on the URL (col.6, lines 4-10, it is inherently known that server with Internet connectivity requires a web access module such as modem or Ethernet); and

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- c. A render module to receive the retrieved Internet-related service n proximity to the mobile system (col.4, lines 37-41, col.7, lines 13-18, 28-43).

10. As per claim 2, Cardillo taught the invention as claimed in claim 1. Cardillo further taught that the handheld device fits into a user's palm (palm PDA, col.1, lines 28-32, col.2, lines 28-31).

11. As per claims 4 and 33, Cardillo taught the invention as claimed in claims 1 and 32. Cardillo further taught a communication module in the handheld device that receives the URL from a remote site via a second communication link coupled to the communication module (col.6, lines 24-36, it is inherently known that data received from the NAV can include URL).

12. As per claims 10-11 and 15-16, Cardillo taught the invention as claimed in claims 1 and 13. Cardillo further taught that the web access module communicates with the remote web server via the Internet communication link using an open standard communication protocol such as HTTP (col.3, lines 4-16, col.7, lines 1-12).

13. As per claim 19, Cardillo taught the invention substantially as claimed in claim 1. Cardillo further taught wherein the web access module comprises a web browser without a rendering function (col.6, lines 4-16, col.7, lines 1-26).

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14. As per claim 20, Cardillo taught the invention substantially as claimed in claim 1.

Cardillo further taught that the rendering system is a device-specific rendering system (col.4, lines 37-41, col.7, lines 13-18, 28-43).

15. As per claim 22, Cardillo taught the invention substantially as claimed in claim 1.

Cardillo further taught that the handheld device is a pager (col.1, lines 28-32, col.2, lines 28-31).

16. As per claims 23, Cardillo taught the invention substantially as claimed in claim 1.

Cardillo further taught that the client module does not have Internet access function and does not include an Internet web browser application program or provide any direct connectivity to the Internet (col.4, lines 46-57, col.5, lines 50-57, fig.2).

17. As per claims 24, Cardillo taught the invention substantially as claimed in claim 1.

Cardillo further taught that the client module has Internet access function and include an Internet web browser, but neither the Internet access function nor the Internet web browser are utilized to send the URL via the local communication link (col.2, lines 24-47).

### **Claim Rejections - 35 USC § 103**

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



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19. Claims 3, 5-9, 12, 14, 17-18, 21, 25-28, 30-31 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cardillo, IV et al (hereinafter Cardillo), U.S. Patent 5,937,041.

20. As per claims 3 and 30, Cardillo taught the invention as claimed in claims 1 and 29. Cardillo did not specifically teach to further comprising a memory coupled with the handheld device to store at least one URL, wherein the URL sent is selected from the at least one URL. However, it is well known in the art that many handheld devices contain memory to store data. For example, memory are provided in cell phones to store phone and contact information. Cardillo further taught that the client device can store data (col.6, lines 24-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo and further provide memory to the handheld device to store URL for user to bookmark desired web pages.

21. As per claim 5, Cardillo taught the invention as claimed in claim 4. Cardillo did not specifically teach that the second communication link is a link to a wireless network. However, it would have been obvious to use link to a wireless network for portable devices. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the second communication link linking to a wireless network in Cardillo's system to provide wireless communication for portable device and reduce the need of physical connection.

22. As per claims 6 and 21, Cardillo taught the invention as claimed in claim 1. Cardillo further taught that the handheld device is selected from a group of devices consisting of: a pager

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device, a cellular phone device, a personal organizer device, and a palm pilot device (col.1, lines 28-32, col.2, lines 24-31). Cardillo did not specifically teach that the handheld device consisting of a watch device and an information appliance device. However, many different portable devices can be selected and used in Cardillo's system. It would have been a design choice to pick and select all suitable handheld devices usable in the taught invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select any suitable handheld devices as the handheld device taught by Cardillo so to enable users of different types of handheld devices to have the ability to access and communicate with the web access module taught in Cardillo's system and retrieve web page contents.

23. As per claims 7 and 34, Cardillo taught the invention as claimed in claims 1 and 33. Cardillo did not specifically teach that the receiver, the web access module, and the render system all physically reside within a single enclosure separate from the handheld device. However, it would have been obvious that the receiver, the web access module and the render system can be enclosed together as a single system rather than three independent devices which may take up more spaces. It would have been obvious to one of ordinary skill in the art at the time the invention was made to build the receiver, the web access module and the render system in Cardillo's system within a single enclosure separate from the handheld device as a single unit to save space.

24. As per claims 8-9 and 17-18, Cardillo taught the invention substantially as claimed in claims 1 and 13. Cardillo did not specifically teach that the communication link is a wireless

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communication link and is selected from a group of communication links consisting of: an infrared communication link, a radio frequency communication link, a microwave communication link, a laser communication link, and combination thereof. However, it is of a design choice for one of ordinary skill in the art to implement different types or combinations of these listed communication links as the wireless communication link. Furthermore, one of ordinary skill in the art would have been motivated to select types of wireless communication links according to the users' needs or cost of implementation to provide better mobility. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo and a use of wireless communication link of any type or combination of types to eliminate the needs for using physical cables and fully advance the mobility of handheld devices.

25. As per claims 12, 14 and 27-28, Cardillo taught the invention substantially as claimed in claims 1 and 13. Cardillo did not specifically teach that the render system further comprises at least one render system selected from a group of systems consisting of: a printer system, a display system, a projection display system, a user interface display system, an audio/video player system, a Web television system, and a combination thereof. However, it is of a design choice for one of ordinary skill in the art to select different types or combinations of outputting systems as the rendering system according to different needs. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Cardillo and a use of outputting systems of any type or combination of types as the rendering

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system to display or print the desired contents to provide the users' different needs (i.e. presentations, reports).

26. As per claim 25, Cardillo taught the invention substantially as claimed in claim 1. Cardillo did not specifically teach wherein only the URL is communicated, and the URL is communicated by sending only a few bytes of data. However, it would have been obvious that URL can be communicated by sending only a few bytes of data since URLs are relatively small in size. It would have been obvious to one of ordinary skill in the art at the time the invention was made to communicate the URL by sending only a few bytes of data since URL is known to be small in size for transmission.

27. As per claim 26, Cardillo taught the invention substantially as claimed in claim 1. Cardillo did not specifically teach that the URL is in the actual URL form or embedded in a hyperlink. However, it would have been obvious to one of ordinary skill in the art to recognize that the URL is in the actual form or embedded in a hyperlink since they are the most common formats. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide URL in the actual URL form or embedded in a hyperlink to Cardillo's system since they are widely used in the art.

28. As per claims 31, Cardillo taught the invention substantially as claimed in claim 30. Cardillo further taught a communication module in the handheld device that receives the URL from a remote site via a second communication link coupled to the communication module

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(col.6, lines 24-27, it is inherently known that data received from the data center can include URL).

29. As per claim 35, it is a combined claim of claims 1, 7 and 12. Therefore, it is rejected with the same reasons and motivations in combination using the rejection of claims 1, 7 and 12.

### **Conclusion**

30. Applicant's arguments with respect to claims 1-35, filed on 8/13/2003, have been considered but are not persuasive and are moot in view of the new ground(s) of rejection.

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kariya, US 6,169,897.

Potts, Jr., US 6,314,432.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenny Lin whose telephone number is (703)305-0438. The examiner can normally be reached on 8 AM to 5 PM Tuesday to Friday and every other Monday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. Additionally, the fax numbers for Group 2100 are as follows:


Official Responses: (703) 746-7239

After Final Responses: (703) 746-7238

Draft Responses: (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-6121.

ksl  
November 4, 2003

  
**ZARNI MAUNG**  
**PRIMARY EXAMINER**